

REMARKS

Attached hereto is a revised Reissue Declaration which removes the unnecessary amendments to Claims 1 and 4 that could have been corrected via a Certificate of Correction.

The other amendments to the claims are directed to the word "successively" and are properly set forth in the Reissue Declaration if the Recapture Rule cited in the Rejection is properly interpreted.

Applicant properly filed within the two-year limit of 35 U.S.C. § 251 and is entitled to a broadened reissue claim in accordance with MPEP § 1412.03. In making that determination, the MPEP suggests a two-step test for recapture, as set forth in *In re Clement*, 131 F.3d 1464, 1468-69 (Fed. Cir. 1997).

The first step in determining the applicability of the Recapture Rule is to determine in what aspect the reissue claim is broader than the original patent claims. Applicant wishes to remove "successively" as a limitation which defines the manner in which, for example, pieces of page information are stored in a storage area. See Claim 1, subparagraph (a), which removes this limitation, and therefore it can be considered to be a broadening of that element of Claim 1.

It is necessary, however, to determine how the claim element of Claim 1, subparagraph (a), is, in fact, broadened by removing the term "successively". Thus, does the recording medium define the pieces of page information as being stored successively (e.g., one after another) in the storage area or, are the pieces of page information to be stored in successive (e.g., adjacent) storage areas.

As presumably the Examiner is aware, when information is stored on a recording medium such as a hard disc, there is usually not an attempt to physically store data in physically adjacent

or successive areas in the storage area, and an act of storing, one after another, does not particularly distinguish over a conventional manner of storing a plurality of data.

Thus, the proposed amendment to our present independent Claim 1 is simply to remove any possible ambiguity in the term "successively" since neither the timing or manner of "successively" storing or locating the data "successively" in a storage area was ever an issue in either defining the invention or an issue in the prosecution of the claimed invention in the U.S. Patent Office. The purpose of filing the Reissue Application is to remove any potential issue of interpretation that may be attempted by an infringer in the future to take advantage of such language since it was not required by the cited prior art.

Compare, for example, Claim 16, subparagraph (c), of our present application, which defines a page information storing means for having a plurality of separate small storage areas, each of which is used for storing at least a piece of page information made up of multimedia information that describes contents of a plurality of screen images. This claim is not burdened by the terminology "successively". Moreover, what Claim 16 does have in common with Claim 1 is the same allowable subject matter over the same prior art which was argued and accepted by the Examiner during the prosecution of the parent application, namely, "piece of page information" and "plurality of screen images". Even the present Office Action acknowledges that Applicant actually argued that the prior art failed to teach "pieces of page information" and "plurality of screen images". For this reason, the U.S. Patent Office initially allowed the present application with an Ex Parte Quayle, but then rescinded the allowance purportedly on the basis of the case of *Pannu v. Storz Instruments, Inc.*, 59 U.S.P.Q. 1597 (Fed. Cir. 2001). It should be noted that the MPEP acknowledges that simply stating that limitations of the claims distinguish

over the teaching of the prior art constitutes "a general argument" which by itself is not sufficient to establish a surrender and recapture.

To meet the second step of *In re Clement*, the Patent Office has the burden of closely reviewing the prosecution history and expressly pointing out how Applicant relied on the term "successively" to distinguish over the cited prior art. The Patent Office has failed this requirement.

During the prosecution of the claims in the issued U.S. Patent No. 5,767,845, the same identical prior art of *Ohba et al.*, U.S. Patent No. 5,214,758, and *Edmunds et al.*, U.S. Patent No. 5,592,602, were also applied against independent Claims 13 and 19, which did not contain the limitation "successively", and these claims were also distinguished over the prior art based upon the same arguments and amendments directed to describing a piece of page information as being made up of multimedia information that describes the content of the plurality of screens images. Thus, it is clear that the prosecution history does not support any argument that "successively" was utilized to distinguish over any issue of prior art and, in fact, identically rejected claims over the same art not containing the limitation "successively" as presently contained in the '845 patent.

The crux of the matter is whether the Office Action has properly determined whether the broader aspects of the Reissue Claim relate to subject matter that Applicant previously surrendered during the prosecution of the original Application.

Since each case must be determined on its own fact pattern, a careful review of the prosecution history of the present application and the parent application has to be undertaken. It is presumed that Applicant has already distinguished over the fact pattern and circumstances set forth in the earlier cited cases, and it is believed that now a review must be made in view of the

newly cited case, *Pannu v. Storz Instruments, Inc.*, *supra*, which was the basis for withdrawing the Notice of the Allowance under the Ex Parte Quayle. Making such a comparison, however, further distinguishes our fact pattern and circumstances from the *Pannu* case.

Our claim language inadvertently included an adverb "successively" referring to an act of storing in a storage space in original Claim 1 and other claims. The original rejection in the parent application indicated an allowable subject matter in certain dependent claims while rejecting, for example, Claim 1 over a combination of the *Ohba et al.* patent, in view of the *Edmunds et al.* patent. Reviewing the Office Action, however, discloses that the Examiner never mentions, refers to or implies that "successively" in any way represented an issue that was in contention in the parent case or was a teaching of the prior art.

Rather the *Ohba et al.* reference was cited to include a disc with page information including a partial image, information reading means, a display data creation means, display means, input means and a command execution means. The Office Action further acknowledged that the *Ohba et al.* reference did not disclose page information including display state information and control information, but rather relied upon the *Edmunds et al.*, reference to disclose apparatus for segmenting a multimedia object's duration into a plurality of time segments. The Examiner then concluded that it would be obvious to a person with ordinary skill to integrate a disc with page state information and control information with various time segments of an object's duration on display.

The Examiner further combined the MacroModel text with the *Ohbata et al.* and *Edmunds et al.*, references to teach a method for building images for animation including a display and method to modify X-Y coordinates, along with a rotation tool to allow rotation of the object. Finally, the Examiner cited the *Silverbrook* U.S. Patent No. 5,566,290 for combination

with *Ohba et al.*, and *Edmunds et al.*, for the teaching of a multimedia display device for storage, production and reproduction with connection to a network interface. The Examiner indicated allowable subject matter was contained within the dependent claims.

The term "successively stored" was never an issue of allowance nor a basis for a rejection.

Applicant in the Amendment of August 25, 1997, responded with amendments set forth to address 35 U.S.C. § 112 issues and with regards to Claim 1, modified the definition of the page information to indicate that it was pieces of page information and further modified the Claim to identify what each piece of the page information was made up of, namely, multimedia information that describes contents of a plurality of screen images. The original claim language, that inadvertently included the term "successfully stored", was never addressed in the amended claim nor in fact in the arguments presented relative to the cited references. Thus, the Applicant when initially describing the invention had inadvertently used the word "successively" as an unnecessary limitation relative to the act of storing the pieces of page information in a storage area.

Further undermining the contention that "successively" stored was a necessary limitation to distinguish over the prior art, it should be noted, that Claim 13 was also rejected over the same references of *Ohba et al.*, and *Edmunds et al.*, when further combined with *Silverbrook* for showing information that was provided by a data server over a network. Note, Claim 1 referred to the data being on a disc, while Claims 13 and 19 were not limited to a disc, but received information by a network. Faced with the same rejection, Applicant, again, provided amendments to Claims 13 and 19 that were only directed to further describing the piece of page information as being made up of multimedia information that describes the content of the

plurality of screens images. In Claim 13, the language called for a page information read means for reading the piece of page information without any reference to "successively stored" while Claim 19 referred to a page information storage means for having a plurality of separate small storage areas for which each can store at least a piece of page information. Claim 19 further defined a control information write means for writing the controlled information into a second storage area in the page information storage means, but made no reference to a "successive" storage capability.

Thus, the actual claims allowed and the prosecution history clearly disclose that there was no intention exhibited by the Applicant in inadvertently leaving the terminology "successively" in certain claims, while not having it in other claims that were allowed over the same references of record.

The present Office Action contended that Claims 1-26 were rejected under 35 U.S.C. § 251 as being an improper recapture of claim subject matter surrendered in the parent application. The Office Action attempts to construe Applicant's comments on the cited prior art rejection as including arguments that the prior art failed to teach pieces of page information successively stored in a storage area in a disc. The Office Action, however, in fairness noted that the emphasis of the argument involved the aspect of pieces of page information and plurality of screen images. The Office Action misconstrues apparently the first full paragraph on page 34 as allegedly an argument that would support a Recapture Rule. Comparing the first sentence of this paragraph, however, with Claim 1 amended, clearly discloses the intent of the Applicant to simply substantially repeat the amended subparagraph (a) with an actual emphasis on the underlying pieces of page information. Thus, the first sentence is basically a quotation of subparagraph (a) and simply repeated the terminology "successively stored in a storage area" to

present the context of Claim 1. It can be readily seen, however, that other independent claims for which the same arguments over the prior art were applied were not so limited and that there was no effort or representation of Applicant in making any type of argument based on "successively stored in a storage area on disc". The actual argument advanced against the cited reference is found in the contents of pages 34-35 as follows:

Accordingly, the idea of reading out a piece of page information which includes a plurality of screen images from a disc is not disclosed or suggested by the combination of Ohba et al. and Edmunds et al. Meanwhile, the claims of the present invention recite that a piece of page information describing the contents of a plurality of screen images are stored on a disc, where a plurality of screen images are read at a time with the piece of page information being read. As result, the multi-media playback device of the present invention can reproduce highly responsive multi-media data, even if the transfer rate of disc data from a CD-ROM is low. The amount if display data which can be displayed per unit time is not limited by the data transfer rate between the disc and the memory. Thus, the display image update is prevented from being suspended upon awaiting information from the disc, so that the multi-media information playback device will rarely be in a waiting state. (Underline added.)

As can be seen, the Examiner allowed not only Claim 1 without any reference to "successively" stored, but further allowed Claims 13 and 19 that don't mention "successively" stored. Note, for example, the Reasons for Allowance submitted by the Examiner in the Notice of Allowability of November 26, 1997 at page 2. There is clearly no discussion or suggestion that the claim terminology "successively" was a factor in the allowance of either Claims 1, 13 and 19.

Further, as noted on page 35, paragraph 3, of the amendment in the parent application, it describes "Storing a piece of page information describing the contents of a plurality of screen images on a disc and reading a plurality of screen images from the disc at one time when the

piece of page information is read", and this portion is followed by the understanding that the claimed limitation is not taught nor suggested by the cited references.

The Examiner cited the above sentence in his statement of Reason for Allowance issued on November 26, 1997.

The *Pannu v. Storz Instruments, Inc.* case discloses a claim directed to a universal, intraocular lens that can be inserted into either an anterior chamber or a posterior chamber of a human eye. During the prosecution of the parent application, the Patent Office rejected of each of the outstanding claims as being obvious under 35 U.S.C. § 103 in view of four prior art references. One of the cited references was the *Shearing*, U.S. Patent No. 4,159,546. The undersigned attorney is very familiar with both the *Shearing* reference and the then state of art in this medical field since he was lead attorney in a patent infringement lawsuit based upon the *Shearing* '546 patent for over one year.

Shearing disclosed an intraocular lens body that could be inserted within a "bag" resulting from the emulsification of an actual capsule of a cataract eye, in the posterior chamber behind the iris of the eye. The doctor literally places a hook in the pupil of the iris, extends it, pierces the human eye and vacuums out the gel of the lens capsule to in essence leave the capsule or "bag" without damaging the tendons attached to the bag. In order to secure the replacement plastic lens body within the bag, haptic or perimeter extensions from the lens body were utilized. The *Shearing* reference taught a retention loop of a flexible nylon strand attached at one end to the lens and extending out in a J-shape with a free open end as shown in Figure 1 below. The *Pannu* application had a different haptic configuration as shown in Figure 1 of the Re. 32,525.

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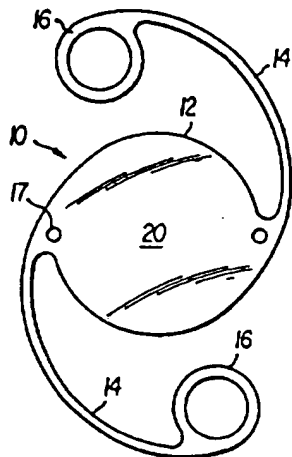


FIG. 1

SHEARING

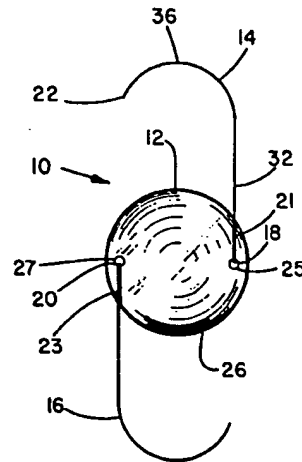


FIG. 1

Pannu amended the rejected claim and attempted to define over the *Shearing* J-shaped configuration by the definition of the haptic loop being a "continuous, substantially circular arc having a diameter greater than the diameter of the lens body". The *Shearing* lens did not have a continuous substantially circular arc, and the diameter of the J was not necessarily greater than the diameter of the lens body.

Pannu specifically argued the distinction of "a continuous substantially circular arc having a diameter greater than the diameter of the lens body." *Pannu* contended that this configuration significantly enhanced the easy insertability of the applicant's lens and significantly reduced any possibility of snagging delicate eye tissue. Based on these arguments, Claim 16 issued as Claim 1 of the *Pannu* '855 patent. *Pannu* then filed for a reissue application and specifically sought to remove the exact claim language which was added by amendment and relied upon by the Examiner in granting the previous Claim 16, namely, "a continuous

substantially circular arc having a diameter greater than the diameter of the lens body." The Examiner permitted such a reissue amendment but only upon requiring *Pannu* to insert additional limitations directed to the physical size of the snag-resistance means or disc by requiring it to be three times greater in size than the width of the flexible element.

The Federal Court of Appeals applied the two steps of the *Clement* case and found that the reissue claim was broader by removing the definition of a haptic as "defining a continuous substantially circular arc having a diameter greater than the diameter of said lens body". The Court of Appeals could easily determine that this was subject matter that had been surrendered, e.g., there was a specific argument and language added to the claim to distinguish over the cited prior art such as *Shearing*. The Federal Court of Appeals then went forward and determined that even if the snag-resistant means was further limited, that this was unrelated to the broadening of the description of the flexible haptic member. Thus, the Federal Court of Appeals correctly found that the arguments associated with the snag-resistant means being narrower did not overcome the fact that the earlier claim language on the haptic feature had been added for distinguishing over the *Shearing* patent and was now removed in the reissue claim.

The *Pannu* case does not provide any teaching nor suggestion that our present claims and prosecution history are in any manner similar to the facts of the *Pannu* case.

Our prosecution history included only one amendment which is acknowledged by the Office Action to be arguing distinct features unrelated to "successively".

The original patent claims, that were allowed included independent claims that did not include the word "successively" when relating to storage, but regrettably also included allowed claims that inadvertently included the word "successively". The same prior art was applied to

both allowed claims without the word "successively" and allowed claims that used the word "successively."

There was never an amendment to add the word "successively" nor was there any specific argument nor reason to argue that "successively" was a distinguishable feature over the cited prior art. The prior art was more than adequately distinguished over by the actual arguments made and other amendments to the claims.

Clearly, the *Pannu* reference does not stand for any teaching that Applicant has failed the step-two test in the *In re Clement* case. The *Pannu* case rather further bolsters Applicant's position that its prosecution history never argued, amended, nor attempted to address any issue of "successively" as a distinguishing feature of the prior art. "Successively" was inadvertently included in some allowed claims while not being included in other allowed claims, and the present Reissue Application properly addresses this unnecessary limitation to those allowed claims by removing the terminology "successively".

It is respectfully submitted that the Recapture Rule has not been appropriately applied and that the Office Action has failed to justify its position in accordance with the standards of the MPEP. Applicant requests reconsideration and an indication of allowability. If the Examiner

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believes that a telephone interview will help further prosecution of this case, he is respectfully requested to contact the undersigned attorney at the listed telephone number.

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, Express Mail Label No. EV 261493052 in an envelope addressed to the Box AF, Assistant Commissioner for Patents, Washington, D.C. 20231 on March 25, 2003.

By: James Lee




Signature

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Very truly yours,

SNELL & WILMER L.L.P.


Joseph W. Price *Reg No. 42,998*
Registration No. 25,124
1920 Main Street, Suite 1200
Irvine, California 92614-7230
Telephone: (949) 253-4920